

Serial No.: 08/701,278
Filed: August 22, 1996

"inconsistent" with that of the provisional application from which this case claims priority.

Applicants submit that the MPEP, Section 201.04, (enclosed) in the discussion of 37 CFR 1.48(e) states that:

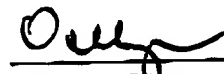
An error in naming a person as an inventor in a provisional application would not require correction by deleting the erroneously named inventor from the provisional application since this would have no effect upon the ability of the provisional application as a basis for a priority claim under 35 U.S. C. 119 (e).

Thus, it appears that as long as there is one inventor in common as in the present case, priority can be claimed.

Applicants respectfully submit that if any issues which preclude allowance remain, please call the under-signed at (415) 781-1989 to resolve such issues.

Respectfully Submitted,

**FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP**



Dolly A. Vance
Reg. No. 39,054

Four Embarcadero Center, Suite 3400
San Francisco, CA 94111-4187

Dated: June 14, 1999

201.04

MANUAL OF PATENT EXAMINING PROCEDURE

inventor is not being improperly deleted from the application. Written consent of any assignee is not required for petitions filed under 37 CFR 1.48(b).

When any correction or change is effected, the file should be sent to the Application Division for revision of its records and the change should be noted on the original oath or declaration by writing in red ink in the left column "See Paper No. ___ for inventorship changes". See MPEP § 605.04(g).

37 CFR 1.48(c)

37 CFR 1.48(c) provides for the situation where a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application as filed. In such a situation, the nonprovisional application may be amended pursuant to 37 CFR 1.48(a) to add claims to the subject matter and also to name the correct inventors for the application. The claims would be added by an amendment and, in addition, an amendment pursuant to 37 CFR 1.48(a) would be required to correct the inventors named in the application. Any claims added to the application must be supported by the disclosure as filed and cannot add new matter.

37 CFR 1.48(d)

37 CFR 1.48(d) provides a procedure for adding the name of an inventor in a provisional application, where the name was originally omitted without deceptive intent. 37 CFR 1.48(d) does not require the verified statement of facts by the original inventor or inventors, the oath or declaration by each actual inventor in compliance with 37 CFR 1.63, or the consent of any assignee as required in 37 CFR 1.48(a). Instead, the procedure requires the filing of a petition identifying the name or names of the inventors to be added and including a statement that the name or names of the inventors were omitted through error without deceptive intention on the part of the actual inventor(s). The statement would be required to be verified if made by a person not registered to practice before the PTO. The statement could be signed by a registered practitioner of record in the application or acting in a representative capacity under 37 CFR 1.34(a). The petition fee set forth in 37 CFR 1.17(q) would also be required.

37 CFR 1.48(e)

37 CFR 1.48(e) provides a procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application. Under 35 U.S.C. 119(e), as contained in Public Law 103-465, a later filed application under 35 U.S.C. 111(a) may claim priority benefits based on a copending provisional application so long as the applications have at least one inventor in common. An error in naming a person as an inventor in a provisional application would not require correction by deleting the erroneously named inventor from the provisional application since this would have no effect upon the ability of the provisional application to serve as a basis for a priority claim under 35 U.S.C. 119(e). However, 37 CFR 1.48(e) sets forth the requirements for deleting the name of a person erroneously named as an inventor in a provisional application. The procedure requires an amendment deleting the name of the person who was erroneously named accompanied by: a petition including a statement of facts verified by the person whose name is being deleted establishing that the error occurred without deceptive intention; the fee set forth in 37 CFR 1.17(q); and the written consent of any assignee.

201.04 Parent Application [R-1]

The term "parent" is applied to an earlier application of an inventor disclosing a given invention. Such invention may or may not be claimed in the first application. Benefit of the filing date of copending parent application may be claimed under 35 U.S.C. 120. The term parent will not be used to describe a provisional application.

201.04(a) Original Application [R-2]

"Original" is used in the patent statute and rules to refer to an application which is not a reissue application. An original application may be a first filing or a continuing application.

201.04(b) Provisional Application [R-3]

35 U.S.C. 111 Application.

...

(b) PROVISIONAL APPLICATION.—

(1) AUTHORIZATION.—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

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FLEHR HOHBACH TEST

NO. 0617 P. 1

FLEHR
HOHBACH
TEST
ALBRITTON
& HERBERT

LLP Intellectual Property Law

OFFICIAL

FACSIMILE TRANSMITTAL SHEET

Telephone: (415) 781 1989

Fax: (415) 398-3249

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JUN 15 1999

GROUP 1600

4 Embarcadero Center

Suite 3400

San Francisco, CA

94111-4187

June 14, 1999

PLEASE HAND DELIVER UPON RECEIPT

TO: Examiner Hayes

TELECOPIER

NUMBER: 703/308-4242

FROM: Dolly Vance

Our File: A-63770-1/RFT/DAV

MESSAGE:

Attached please find a Response to Advisory for Serial No. 08/701,278.

NUMBER OF PAGES (including transmittal sheet): 4

If you do not receive clear copies of any pages, please let us know.

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